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# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/011,797	07/23/1998	MARC PARMENTIER	VANMA72.001A	1370

7590

12/03/2001

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EXAMINER

MURPHY, JOSEPH F

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 12/03/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/011,797

Applicant(s)

PARMENTIER ET AL.

Examiner

Joseph F Murphy

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35,37-42,47,51,52 and 59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35,37,38,41,42,47 and 59 is/are allowed.
- 6) ☒ Claim(s) 39,40,51 and 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Sequence Comparison A*.

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## **DETAILED ACTION**

### ***Formal Matters***

Claims 36, 48-50, 57 and 58 were cancelled, new claim 59 was added, and claims 35, 37-42, 51 and 52 were amended in Paper No. 17, 10/9/2001.

Claims 35, 37-42, 47, 51-52 and 59 are pending and under consideration.

The finality of the previous Office action has been withdrawn based on the new ground of rejection set forth below.

### ***Response to Amendment***

The rejection of remaining claims 35, 38 and 47 under 35 USC § 112, first paragraph has been obviated by Applicant's amendment, and is thus withdrawn

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 39, 40, 51-52 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,837,809 (Grandy et al. 1998). U.S. Patent No. 5,837,809 has a priority date of Aug. 11, 1995.

Grandy et al. discloses ligands for a mammalian opioid receptor. One of the ligands disclosed as SEQ ID NO: 5 by Grandy et al. is 100% identical to the polypeptide with an amino acid sequence set forth in SEQ ID NO: 2 (see Sequence Comparison A, attached; also see

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column 18, lines 51-53), thus claim 39 is anticipated. Grady et al. discloses that the peptide can be produced by molecular or genetic engineering means (column 9, lines 27-28), thus claim 40 is anticipated. Grady et al. discloses a method of screening for agonists or antagonists of opioid binding to receptor comprising expression of the receptor in host cells, isolation of cell membranes and use of the membranes to screen compounds for their effect on opioid binding activity, thus claims 51-52 are anticipated.

### ***Conclusion***

Claims 39, 40, 51-52 are rejected.

Claims 35, 37-38, 41-42, 47, and 59 are allowable.

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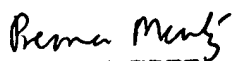
***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
November 29, 2001

  
**PREMA MERTZ**  
**PRIMARY EXAMINER**